

Appl. No. 10/730,438
Docket No. CM2713Q
Response dated August 7, 2009
Reply to Office Action mailed on May 7, 2009
Customer No. 27752

REMARKS

Claim Status

Claims 1 – 11 are pending in the present application.

All claims stand rejected.

Rejection Under 35 USC §103(a) Over Schleinz et al. in view of Burazin et al.

Claims 1-4, 7, 10 and 11 stand rejected over Schleinz et al. (USPN 5,458,590) in view of Burazin et al. (US App. Pub. No. 2002/0112832). Applicants respectfully traverse the rejection, for two reasons. First, the references, alone or in combination, do not disclose all elements of Applicants' claims. Second, Applicants believe that a showing of a teaching, motivation or suggestion of a combination of these references is not present.

As discussed below, Applicants believe that Claim 1 is patentable over the prior art references most recently cited. If Claim 1 is patentable, it follows that the remaining claims, being narrower in scope, are patentable as well. Therefore, without waiving any arguments they may otherwise have, Applicants defer arguments concerning rejection of Claims 5 and 6 over Schleinz et al. in view of Burazin et al., further in view of McCormack et. al. (USPN 6,719,742).

A. Requirements for *Prima Facie* Case of Obviousness

1. *Claimed Invention As A Whole Must Be Considered.*

Under MPEP §2142, the Office bears the burden of factually supporting an asserted *prima facie* conclusion of obviousness. In determining the differences between the cited art and the claims, the question is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *See, e.g., Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1537; 218 U.S.P.Q. 871 (Fed. Cir. 1983). If the Office does not demonstrate *prima facie* unpatentability, then without more, the Applicant is entitled to the grant of the patent. *See In re Oetiker*, 977 F.2d 1443, 1445; 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992).

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2. *All Claim Elements Must Be Taught Or Suggested By Prior Art.*

To establish a *prima facie* case of obviousness under 35 U.S.C. §103, the Office must show that all of the claim elements are taught or suggested in the prior art. *See, e.g., CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342; 68 U.S.P.Q.2d 1940 (Fed. Cir. 2003).

3. *A Teaching, Motivation or Suggestion to Combine the Cited References Must be Found in the Prior Art.*

[A] patent [claim] composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.

KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1741, 82 U.S.P.Q.2D 1385 (2007).

Although the Supreme Court in *KSR* rejected rigid application of a rule requiring demonstration of a teaching, motivation or suggestion within prior art references to combine them as a basis for a conclusion of obviousness, it did not abrogate the requirement. Rather, recognizing that the TSM requirement captured a “helpful insight,” the Court suggested its approval of the TSM analysis within a flexible approach. *See id.* at 1741, 1743. Accordingly, the Federal Circuit has subsequently stated:

[A] flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of invention.”). The TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence—teachings, suggestions (a tellingly broad term), or motivations (an equally broad term)—that arise before the time of invention as the statute requires. As *KSR* requires, those teachings, suggestions, or motivations need not always be written references but may be found within the knowledge and creativity of ordinarily skilled artisans.

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Ortho-McNeil Pharmaceutical, Inc. v. Mylan Labs., Inc., 520 F.3d 1358, 1364-1365; 86 U.S.P.Q.2D 1196 (Fed. Cir. 2008) (judgment of nonobviousness and infringement affirmed).

. . . There is no suggestion to combine [references] . . . if a reference teaches away from its combination with another source. *See id.* at 1075, 5 U.S.P.Q.2D (BNA) at 1599. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . . [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 U.S.P.Q.2D (BNA) 1130, 1131 (Fed. Cir. 1994). If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination. *In re Spinnoble*, 56 C.C.P.A. 823, 405 F.2d 578, 587, 160 U.S.P.Q. (BNA) 237, 244 (CCPA 1969); *see also In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. (BNA) 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperable for its intended purpose).

Tec Air, Inc. v. Denso Mfg. Michigan Inc., 192 F.3d 1353, 1359-1360; 52 U.S.P.Q.2d 1294 (Fed. Cir. 1999). "It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one skilled in the art." *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448, 230 U.S.P.Q. 416 (Fed. Cir. 1986), *quoting In re Wesslau*, 353 F.2d 238, 241, 147 U.S.P.Q. 391, 393 (C.C.P.A. 1965).

B. Analysis

1. *The Combination of Cited References Does Not Teach or Suggest All Elements of Applicants' Claims.*

Claim 1 recites a disposable article selected from baby diapers, pull-on diapers, pants or adult incontinence diapers comprising, *inter alia*, a backsheet that comprises at least one polymeric film and at least one nonwoven web formed of fibers, wherein said polymeric film and said nonwoven web each have two major surfaces, said polymeric

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film comprises a polymeric film material, and said nonwoven web fibers comprise a polymeric nonwoven web material, wherein at least one of said polymeric film material or said polymeric nonwoven web material is color-pigmented by one or more pigments mixed thereinto prior to formation of said polymeric film or said nonwoven web, and wherein at least one of said polymeric film or said nonwoven web has visually discernible printed ornamental designs, said printed ornamental designs being provided by printing a pigmented ink onto at least one of said major surfaces of at least one of said polymeric film or said nonwoven web, and said polymeric film being joined in an overlaying region across at least part of one of its major surfaces to at least part of an adjacent major surface of said nonwoven web to form said backsheet, and wherein said backsheet in said overlaying region has an L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to 75, an “a” value for red/green-appearance from about -50.0 to about +50.0 and a “b” value for yellow/blue-appearance from about -50.0 to about +50.0, in the areas outside the printed ornamental designs. By dependency, each of the remaining claims includes all of these elements.

Schleinz et al. does not teach or suggest a composite backsheet (*i.e.*, combination of polymer film and nonwoven) having printed ornamental designs, with an L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to 75, an “a” value for red/green-appearance from about -50.0 to about +50.0 and a “b” value for yellow/blue-appearance from about -50.0 to about +50.0, in the areas outside the printed ornamental designs.

Burazin et al. does not teach or suggest a composite backsheet having printed ornamental designs, with an L Hunter value on the Hunter scale for darkness/lightness-appearance from 10 to 75, an “a” value for red/green-appearance from about -50.0 to about +50.0 and a “b” value for yellow/blue-appearance from about -50.0 to about +50.0, in the areas outside the printed ornamental designs. Burazin et al. teaches HunterLab values for *ink used to print patterns* on paper. It does not, however, teach any particular HunterLab values for *areas of the paper outside the printed patterns*. (See, e.g., Burazin et al. at [¶0025] (“the paper product and the masking pattern imparts a two-color

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camouflage to the sheet, the two colors being the color of the sheet (typically white) and the color of the [printing] ink.”))

For this reason, Applicants respectfully submit that the combination of Schlein et al. and Burazin et al. does not teach or suggest all elements of Applicants’ claims, and therefore, does not support a *prima facie* conclusion of obviousness of the claims.

2. *A Teaching, Motivation or Suggestion for the Combination of the Cited References is Absent.*

Schlein et al. addresses the problem of colorfastness of printing of products such as diapers, not the problem of translucency addressed by Applicants. Hence, there is no teaching, motivation or suggestion in Schlein et al. to look for ways to address a problem of translucency – and thus, no teaching, motivation or suggestion to consult other art, within the scope of materials used for diapers or outside that scope – to address translucency.

Burazin et al. address a problem of translucency of *paper products* (*i.e.*, products made from cellulose fiber, *e.g.*, facial tissue – [0017]; [0050]), through printing a masking pattern thereon. However, Burazin et al. is silent concerning whether such a problem exists outside the realm of such paper products, and there is no teaching, motivation or suggestion within Burazin et al. that the technology it discloses has any application outside that realm.

Moreover, elsewhere within prior art previously cited by the Office in this prosecution, it is suggested that a backsheet for an article of the type of Applicants’ claims (*e.g.*, diapers) having colors, outside printed areas, falling within the ranges of Applicants’ claims, *would be undesirable*. (See PTC Application No. WO 99/32164 (by Tao et al.), at page 2, lines 23-26 (“a high degree of whiteness, *i.e.*, the visual appearance of the white color of the article as seen by the consumer, is very important to the consumer”.)

In summary, Schlein et al. contains no suggestion of a combination with other art addressing a problem of translucency; Burazin et al. contains no suggestion of a problem

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of translucency in articles such as diapers, or that the technology it discloses has applicability outside paper products such as facial tissue; and elsewhere in the prior art it is suggested that coloring a diaper backsheet (outside printed regions) to the Hunter L values of Applicants' claims would be undesirable.

For these reasons, Applicants respectfully submit that a teaching, motivation or suggestion of a combination of Schleinz et al. and Burazin et al. is absent.

Conclusion

This response represents an earnest effort to place the present application in proper form for allowance. In view of the foregoing, reconsideration of this application and allowance of the pending claims are respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By



William E. Gallagher
Registration No. 35,145
(513) 983-2522

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